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EXAMINER

NORDMEYER, PATRICIA L

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 03/20/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/831,489

Applicant(s)

VAN DYK ET AL.

Examiner

Patricia L. Nordmeyer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 06 February 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 52-120 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 52-87 and 106-120 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 88-105 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election with traverse of Group I, claims 52 – 87 and 106 - 120 in Paper No. 8 is acknowledged. The traversal is on the ground(s) that the special technical feature is an anti-skinning layer instead of a water based formulation surface. The references cited in the restriction (USPN 4,625,883 and 5,249,692) both have anti-skinning layers used in paint cans, therefore, the special technical feature does not provide a contribution over prior art.

The requirement is still deemed proper and is therefore made FINAL.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 52 – 87 and 106 – 120 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrases “container”, “internal surface” and “container sealing means” in claims 52 – 87 and 106 – 120 are unclear, which renders the claims vague and indefinite. It is unclear in the claim language what is being claimed, a container that an anti-skinning layer on the walls, a lid that prevents skinning of the paint or an anti-skinning article which rests on the interior surface of the container. From the figures, it seems that just a lid of can is being disclosed. Is that all that is trying to be claimed?

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The phrase “adapted to” in claims 52, 65 and 106 is unclear, which render the claims vague and indefinite. It has been held that the recitation that an element is “adapted to” perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchinson*, 69 USPQ 138.

The phrase “capable of” in claims 52, 65 and 106 is unclear, which render the claims vague and indefinite. It has been held that the recitation that an element is “capable of” performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchinson*, 69 USPQ 138.

4. Claim 68 recites the limitation "surface means" in claim 65. There is insufficient antecedent basis for this limitation in the claim. There is not mention of “surface means” in claim 65. For the purpose of examination, the Examiner is assuming it is suppose to read “sealing means”.

Clarification/correction is required.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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6. Claims 52 – 54, 57 – 59, 61 – 68, 71 – 73, 75 – 79, 83, 85, 106 – 109, 111, 114 – 116, 119 and 120 are rejected under 35 U.S.C. 102(b) as being anticipated by Allbrighton (GB 2,306,429 A).

Allbrighton discloses a disc insert, a container sealing means, that prevents the formation of a skin on the surface of paint in a tin (Page 1, lines 2 – 7). Air is prevented from contacting the surface of the paint (Page 1, lines 28 – 31) due to the fact that the insert is contact with a portion of the inner surface of the can (Figure 8 and Page 2, lines 25 - 27). The formulation in the tin is a solvent based gloss paint or any other item which would form a skin on the surface due to the loss of solvent (Page 1, lines 17 – 18 and Page 2, lines 13 – 18). It is inherent that the formulation has a certain concentration of water and solvent and since the disc blocks the air from contacting the surface of the formulation, the disc would inherently maintain the concentration of the formulation. The disc is formed with a foam lining (Page 3, lines 3 – 6 and Page 6, lines 3 – 12), providing insulation from the outside air. Paint is sold in a variety of size containers including 2.5 liters (Figure 1), thereby requiring a variety of sizes of discs for the containers (Page 7, lines 27 – 32). The disc is removed to use the paint in the can and is placed back into the container when the paint use is finished (Page 2, lines 19 – 29).

Regarding the limitations of the anti-skinning layer being integrally molded or thermally bonded to the internal surface of the container in claims 59, 61, 73, 75, 83, 85 and 119, the determination of patentability for a product-by-process claim is based on the product itself and not on the method of production. If the product in the product-by-process claim is the same or

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obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 946, 966 (Fed. Cir. 1985) and MPEP §2113. In this case, the limitation of molding the anti-skinning layer is a method of production and therefore does not determine the patentability of the product itself. Process limitations are given little or no patentable weight. The method of forming the product is not germane to the issue of patentability of the product itself. Further, when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claim in a product-by-process claim, the burden is on the Applicant to present evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. *In re Brown*, 459 F.2d 531, 173 USPQ 685 (CCPA 1972); *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974).

7. Claims 52 – 55, 63 – 69, 106 – 109 and 112 rejected under 35 U.S.C. 102(b) as being anticipated by Graham et al. (USPN 4691,838).

Graham et al. disclose a moist pad in combination with a lid, which prevents the formation of a skin on the surface of paint in a tin (Column 5, lines 10 – 13). Air is prevented from contacting the surface of the paint due to the fact that the membrane is contact with a portion of the inner surface of the can and the foil lid (Figure 1, #14 and 16). The formulation in the tin is a solvent based gloss paint or any other item which would form a skin on the surface due to the loss of solvent (Column 4, lines 54 – 55). It is inherent that the formulation has a certain concentration of water and solvent, and since the disc blocks the air from contacting the

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surface of the formulation, the disc would inherently maintain the concentration of the formulation. The disc is removed to use the paint in the can and is placed back into the container when the paint use is finished (Column 4, lines 65 – 68). As can be seen by Figures 5 – 8, the membrane of the tray is chosen from a variety of different textures.

8. Claims 52 – 54, 60, 62 – 68, 74, 76 – 81, 84, 106 – 109, 111 and 117 are rejected under 35 U.S.C. 102(b) as being anticipated by Burke et al. (USPN 4,625,883).

Burke et al. disclose a floating lid, a container sealing means, which prevents the formation of a skin on the surface of paint in a tin (Column 2, lines 12 - 15). Air is prevented from contacting the surface of the paint due to the fact that the membrane is contact with a portion of the inner surface of the can and the surface of the paint (Figure 1, #10 and Column 1, lines 19 – 23). The formulation in the tin is a solvent based gloss paint or any other item which would form a skin on the surface due to the loss of solvent (Column 2, lines 23 – 26). It is inherent that the formulation has a certain concentration of water and solvent, and since the disc blocks the air from contacting the surface of the formulation, the disc would inherently maintain the concentration of the formulation. The disc is removed to use the paint in the can and is placed back into the container when the paint use is finished (Column 2, line 11). The paint container may have two layers to help prevent air contact with the paint (Figure 1, #10 and 18). The first layer sits in the grooves at the opening of the can (Figure 1, #18) while the second layer is in contact with the formulation and below the circumferential lip of the container (Figure 1,

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#10). In another embodiment of the invention, the anti-skinning layer is adhered to the container in connection with the lid (Column 2, lines 32 – 41 and Figures 4 and 5, #10c).

9. Claims 52 – 54, 62 – 68, 76 – 79 and 106 – 111 are rejected under 35 U.S.C. 102(b) as being anticipated by Merritt (USPN 5,305,909).

Merritt discloses pusher element, a container sealing means, in combination with a flexible bag which prevents the formation of a skin on the surface of paint in a tin (Column 2, lines 20 – 28). Air is prevented from contacting the surface of the paint due to the fact that the membrane is contact with a portion of the inner surface of the can and the surface of the paint (Figure 3 and Column 2, lines 20 – 28). The formulation in the tin is a solvent based gloss paint or any other item which would form a skin on the surface due to the loss of solvent (Column 2, lines 14 – 18). It is inherent that the formulation has a certain concentration of water and solvent, and since the disc blocks the air from contacting the surface of the formulation, the disc would inherently maintain the concentration of the formulation. The disc is removed to use the paint in the can and is placed back into the container when the paint use is finished (Column 3, lines 49 – 55). The plastic bag has a thickness between 0.00025 and 0.03 inches (Column 3, lines 43 – 45).

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:



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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 56, 70, 113 and 118 rejected under 35 U.S.C. 103(a) as being unpatentable over Allbrighton (GB 2,306,429 A).

Allbrighton discloses a disc insert, a container sealing means, which prevents the formation of a skin on the surface of paint in a tin (Page 1, lines 2 – 7). However, Allbrighton fails to disclose the anti-skinning layer is constructed of material selected from the group consisting of woven polyolefin cloth, unwoven polyolefin cloth, gauze, artificial grass matting and glass fiber felt.

Allbrighton discloses the claimed invention except for the material selected from the group consisting of woven polyolefin cloth, unwoven polyolefin cloth, gauze, artificial grass matting and glass fiber felt. It would have been obvious to one having ordinary skill in the art at the time the invention was made replace the foam layer in Allbrighton, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. Therefore, one of ordinary skill in the art would readily determine that the foam could be replaced by one of the other selected materials since the material makes the anti-skinning layer lighter and performs an equivalent function to the foam depending on the desired end results and the absence of unexpected results.

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12. Claim 82 is rejected under 35 U.S.C. 103(a) as being unpatentable over Burke et al. in view of Graham et al.

Burke et al. discloses the claimed invention of an anti-skinning layer in a paint tin except for the second layer being textured.

Graham et al. teaches a membrane with a textured surface (Figures 5 – 8) in a painting tray for the purpose of allowing only a certain amount of paint to be in contact with the roller during the paint process.

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided the textured surface in Burke et al. in order to allow only a certain amount of paint to be in contact with the roller during the paint process as taught by Graham et al.

13. Claims 86 and 87 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burke et al. in view of Gunderson (USPN 5,249,692).

Burke et al. discloses the claimed invention of an anti-skinning layer in a paint tin except for an integrally molded series of space apart concentric ribs integrally molded to a plastics container between the top of the container proximate the sealing means to at least the formulation level and where the integrally molded series of ribs extend from the top of the

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internal surface of the container proximate to the sealing means substantially to the container base.

Gunderson teaches an anti-skinning layer formed with concentric ribs (Figure 1, #10) that sits between the top of the container and the level of the formulation (Figure 3, #10) for the purpose of keeping the curable liquid from being exposed to air, thereby eliminating skinning when the container is partially full.

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided the concentric ribs on the anti-skinning layer of Burke et al. in order to keep the curable liquid from being exposed to air, thereby eliminating skinning when the container is partially full as taught by Gunderson.

Regarding the limitations of the anti-skinning layer being integrally molded in claim 86, the determination of patentability for a product-by-process claim is based on the product itself and not on the method of production. If the product in the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 946, 966 (Fed. Cir. 1985) and MPEP §2113. In this case, the limitation of molding the anti-skinning layer is a method of production and therefore does not determine the patentability of the product itself. Process limitations are given little or no patentable weight. The method of forming the product is not germane to the issue of patentability of the product itself. Further, when the prior art discloses a

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product which reasonably appears to be either identical with or only slightly different than a product claim in a product-by-process claim, the burden is on the Applicant to present evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. *In re Brown*, 459 F.2d 531, 173 USPQ 685 (CCPA 1972); *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974).

### ***Conclusion***

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent No. 4,874,108 to Valasek, U.S. Patent No. 5,213,230 to Kral, U.S. Patent No. 5,339,981 to Kral and U.S. Patent No. 4,625,886 to Eisenman are cited to show the state of the art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L. Nordmeyer whose telephone number is (703) 306-5480. The examiner can normally be reached on Mon.-Thurs. from 7:00-4:30 & alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Y. Pyon can be reached on (703) 308-4251. The fax phone numbers for the

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organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Patricia L. Nordmeyer  
Examiner  
Art Unit 1772

*pln*  
pln

March 13, 2003

*[Signature]*  
HAROLD PYON  
SUPERVISORY PATENT EXAMINER  
*1772*

*3/17/03*